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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,090

04/18/2006

Otto Goettel

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7590  
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05/14/2008

EXAMINER

ELHILO, EISA B

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,090	<b>Applicant(s)</b> GOETTEL ET AL.	
	<b>Examiner</b> Eisa B. Elhilo	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/18/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1        This action is responsive to the applicant's election received by the office on February 28, 2008.

2        Applicant's election with traverse to prosecute the invention of Group II. Election of claims 4-9 is acknowledged. Claims 1-3 and 10-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Therefore, claims 4-9 are pending in this application.

3        The traversal is on the ground(s) that the compounds of formula (1) must be considered as special technical feature that defines a contribution which each of the claimed inventions makes over the prior art because prior art does not disclose the compounds of formula (1).

          The examiner respectfully disagrees with the above argument because the prior art does teach and disclose compounds of the claimed formula (1) and, thus, the compounds of the claimed formula (1) do not considered special technical feature as shown on the following rejection. Therefore, in accordance with M.P.EP 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper.

### ***Claim Rejections - 35 USC § 102***

4        The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

          A person shall be entitled to a patent unless –

Art Unit: 1796

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Terranova et al. (WO 00/43367). The US Patent No. 6,660,046 B1 is used in the rejection as English translation of the Patent WO 00/43367.

Terranova et al. (US' 046 B1) teaches a hair dyeing composition comprising cationic 4,5-diaminopyrazole compound [2-(4,5-diaminopyrazol-1-yl)ethyl]trimethylammonium chloride (see col. 6, lines 1-2), wherein the reference's compound has a formula identical the claimed formula (1) as claimed in claims 4 and 9 (see STIC search report, page 13, the formula), wherein the compound is presents in the amounts of 0.0005 to 12% which within the claimed percentage range as claimed in claim 5 (see col. 7, lines 31-32), wherein the dyeing composition also comprises additional oxidation bases as claimed in claim 6 (see col. 8, lines 13-20), wherein the dyeing composition has a pH in the range of 5 to 11 which within the claimed range as claimed in claim 7 (see col. 7, lines 52-53) and wherein the dyeing composition is mixed with oxidizing agent before use as claimed in claim 8 (see col. 10, lines 56-62). Terranova et al. (US' 046 B1) teaches all the limitations of the instant claims. Hence, Terranova et al. anticipates the claims.

### ***Conclusion***

5        The remaining references listed on from PTO-1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eisa B Elhilo/  
Primary Examiner, Art Unit 1796  
May 8, 2008